

Application Serial No.: 10/674,420
Reply to Office Action dated April 11, 2006

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-63 are presently active in this case, Claims 1 and 47 having been amended by way of the present Amendment. Claims 4, 6-13, 17, 19-24, 28, 29, 36-38, 49, 50, and 53-55 have been withdrawn from consideration. The Applicants respectfully request the entry of the amendments set forth herein.

In the outstanding Official Action, the drawings were objected to under 37 CFR 1.83(a). The objection to the drawings was based upon a recitation in Claim 1 that has been deleted from Claim 1 in the present Amendment. Thus, the objection to the drawings has been rendered moot and, accordingly, the Applicants request the withdrawal of the objection to the drawings.

Claims 1-3, 5, 14-16, 18, 25-27, 30-34, 40-48, 51, 52, and 57-63 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is based upon language in Claim 1 of at least one tube "*having a first end*" (emphasis added), which has been deleted from Claim 1. Thus, the rejection of the claims as being indefinite has been rendered moot and, accordingly, the Applicants request the withdrawal of the indefiniteness rejection.

Claims 1-3, 5, 14-16, 18, 25-27, 30-34, 40-48, 51, 52, and 57-63 were rejected under 35 U.S.C. 103(a) as being unpatentable over Aiken (U.S. Patent No. 3,757,782) in view of Tsao (U.S. Patent No. 5,702,035). Claims 35, 39, and 56 were rejected under 35 U.S.C.

103(a) as being unpatentable over Aiken in view of Gurrera (U.S. Patent No. 5,996,780). For the reasons discussed below, the Applicant traverses the obviousness rejection.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness has not been established in the present case because the cited references, either when taken singularly or in combination, do not teach or suggest all of the claim limitations and there is no evidence of a motivation to modify the references to arrive at the present invention.

Claim 1 of the present application recites an applicator comprising, among other features, at least one tube, at least one plug disposed inside the tube, and at least a first substance contained in an inside space of the tube. A first end of the inside space is defined by the plug, and the plug being arranged, in use, to be expelled together with the first substance when it leaves the inside space of the tube. The applicator further comprises at least one second substance different from the first substance and dissociated therefrom prior to use, where the first and second substances are contained in the applicator such that the first and second substances are expelled at a same end of the applicator. Claim 47 recites an applicator arrangement comprising, among other features, an applicator comprising at least one tube, a first substance disposed in the at least one tube, a second substance, and a plug.

The second substance is dissociated from the first substance at least during a time prior to use, the first and the second substances are contained in the applicator so as to be expelled at a same end of the applicator.

As noted above, Claims 1 and 47 recite first and second substances contained in the applicator so as to be expelled at a same end of the applicator. The Applicants submit that the Aiken and Tsao references, either when taken singularly or in combination, fail to disclose or suggest such features.

The Aiken reference teaches a double ended swab applicator. One version of the applicator includes a tube member (12) constructed such that a single manual pinching compression of the tube medially of its length will rupture temporary seal elements at both ends of the tube, thereby dispensing saturating solution to cotton swab members (18) provided at both ends of the tube member. The Aiken reference also describes an embodiment depicted in Figure 3 in which an internal sealing plug is permanently mounted between the applicator tube ends, thereby subdividing the tube interior into two equal chambers. Thus, a squeeze of either chamber ruptures the membrane for that chamber enabling the liquid therein to be discharged from the respective end of the tube member to saturate the respective cotton swab member at that end.

The Aiken reference does not disclose or suggest an applicator configured to contain first and second substances therein so as to be expelled at a same end of the applicator. The embodiment depicted in Figure 3 of the Aiken reference includes two chambers that are separated by a permanently mounted internal sealing plug, which requires the liquid within each chamber to be discharged to a separate, opposite end of the tube member. No

configuration is disclosed or even suggested in which an applicator is configured such that first and second substances can be expelled at a same end of the applicator.

The Applicants submit that the Tsao reference fails to supplement the deficiency noted above in the teachings of the Aiken reference.

The Tsao reference describes a tubular container that includes a barrel containing liquid. The barrel has an applicator end wrapped by an absorbing element to allow liquid to flow out while another end is sealed. Upon breaking the sealed end, atmospheric pressure will cause the liquid to flow out of the barrel through the applicator end for application. The end of the container with the absorbing element has a liquid silicone stopper disposed therein.

The Tsao reference does not disclose an applicator that contains first and second substances, but rather the Tsao reference describes a container that has a single liquid (74) provided therein. Thus, the Tsao reference does not teach or even contemplate an applicator configured to contain first and second substances therein so as to be expelled at a same end of the applicator. The Applicants respectfully submit that the combination of the teachings of the Aiken reference and the Tsao reference is based on the improper application of hindsight considerations. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants' structure as a template and selecting elements from the references to fill in the gaps. Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness.

Furthermore, the Applicants submit that the combination of the embodiment in Figure 3 of the Aiken reference and the invention described in the Tsao reference would be contrary to the teachings therein. The embodiment in Figure 3 includes a tubular member with a “permanently mounted” internal sealing plug. (Column 1, lines 64-68, of the Aiken reference.) However, the Tsao reference requires a way to allow air (atmospheric pressure) to enter one end of a barrel in order to allow liquid to be discharged from an opposite end of the barrel. It is unclear how the tubular member depicted in Figure 3 of the Aiken reference could be modified to allow atmospheric pressure to enter the tubular member in a manner that would allow the liquid in the tubular member to be discharged therefrom. Additionally, it is unclear how the tubular member depicted in Figure 3 of the Aiken reference could be modified to allow discharge from both chambers via a same end of the tubular member due to the presence of the permanently mounted internal sealing plug. Thus, one of ordinary skill in the art would not have had any motivation to combine these references, since the proposed combination would be inoperable and/or would render the inventions described in the Aiken and Tsao references unsatisfactory for their intended uses and/or would change the principle of operation of the references. (See MPEP 2143.01.)

Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of independent Claims 1 and 47.

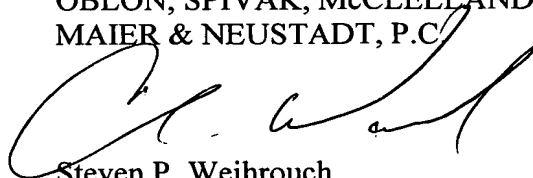
The dependent claims are considered allowable for the reasons advanced for the claim from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

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Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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